

REMARKS

Claims 1-24 remain pending after entry of this amendment.

The Examiner objects to the specification because it lacks a clear brief description of the figures. Applicant amended the specification to provide a brief description of the figures, as well as various headings. Applicant did not add new matter via this amendment. Applicant respectfully requests that this objection be withdrawn.

Claim 5 is rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 926 552, hereafter "'552". Applicant respectfully traverses this rejection.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by GB 2 169 402, hereafter "'402". Applicant respectfully traverses this rejection.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over '402 in view of Takahashi et al. (U.S. Patent No. 5,935,361), hereafter "'361". Applicant respectfully traverses this rejection.

Claims 2-5 and 7-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over '552 in view of '402 in further view of '361. Applicant respectfully traverses this rejection.

Rejections under 35 U.S.C. § 102

Claim 5 is rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 926 552, hereafter "'552". The Examiner asserts that '552 teaches the use of ISO holes (index holes) to measure the start of quality problems (imperfections) on page 2 @ [0008]-[0009]. Applicant respectfully asserts that '552 does not anticipate claim 5.

Paragraph [0009] of '552 is concerned with distinguishing between exposures and different customer orders. It is discussed therein that different exposures and different customer orders are indicated by the creation of an indexing punch hole that is later detected by a sensor to determine the break between exposures or different customer orders. Paragraph [0008] of '552 on the other hand is concerned with linear measurements of continuous webs, and notes that the machinery that is used to make these measurements can sometimes damage the web. The assignment of the defective locations is indicated using linear measurements (page 2, line 41). The discussion of paragraph [0008] and [0009] are separate, therefore '552 does not teach that defective locations are indicated by creation of an indexing punch hole. Therefore, '552 does not anticipate currently pending claim 5.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by GB 2 169 402, hereafter "'402". The Examiner asserts that '402 teaches the position indicating mark 8 in Figure 1a, and the synchronization of the down web coordinate of the mark on page 1, lines 54-60. Applicant respectfully disagrees with the Examiner's characterization of the '402 reference, and asserts that the disclosure of '402 does not anticipate claim 1.

The '402 reference discloses a method and apparatus for detecting tears in a conveyor belt (see title and entirety of patent), which is fundamentally different than the claimed method. A conveyor belt does not have a down web coordinate in the same sense as a down web coordinate is utilized in claim 1. At page 1, lines 1-19 of this application, it is stated that the term "down web" refers to an orientation in the winding direction of a web that is winded on a roll. A conveyor belt is endless and circulating as it is winded around a roll. Therefore, a conveyor belt does not have the characteristics of a web, and certainly not of a continuous web product according to claim 1. Furthermore, a conveyor belt is not windable on a roll and can not have a down web coordinate.

Even if a conveyor belt were not different and distinguishable from the subject of the claimed method, the disclosed method is itself different than that disclosed in '402. Page 1, lines 57 to 60 states that the position of the tear on the belt can be identified as long as the velocity of the belt and the elapsed time between the reference and the tear is known. However, according to claim 1, the measured down web coordinate is synchronized with the indicated down web coordinate of said mark. According to page 3, lines 3-8 of the present application, synchronization is more than identification, in the sense that a correction of the calculation, by for instance an offset value, may also be part of the synchronization. The method of '402 does not allow for such a correction.

Because '402 neither discloses the same method as claim 1 nor performs the method on the same or a similar subject, '402 does not disclose all of the elements of claim 1, and therefore does not anticipate claim 1.

Applicant respectfully requests that the rejection of claims 1 and 5 under 35 U.S.C. § 102 be withdrawn in light of the above remarks.

Rejections under 35 U.S.C. § 103

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over '402 in view of Takahashi et al. (U.S. Patent No. 5,935,361), hereafter "'361".

In order to establish *prima facie* obviousness, three basic criteria must be met, namely: (1) there must be some suggestion or motivation to combine the references or modify the reference teaching; (2) there must be a reasonable expectation of success; and (3) the reference or references when combined must teach or suggest each claim limitation. Applicant submits that the Office Action failed to state a *prima facie* case of obviousness, and therefore the burden has not properly shifted to Applicant to present evidence of nonobviousness.

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness at least because the references, when combined do not teach all of the elements of claim 6. As stated above, the disclosure of '402 does not and cannot have any relation to a product having down web coordinates. Therefore '402 cannot disclose a detecting system for detecting down web coordinates on a web, in contrast to the subject matter of claim 6. Furthermore, as argued above, '402 does not disclose a method that utilizes synchronization. Therefore, '402 cannot disclose one or more product inspection systems providing length measuring circuitry synchronized with semidetected down web coordinates. The '361 patent does not offer the elements missing from the '402 patent.

Applicant also asserts that the Examiner has failed to establish a *prim facie* case of obviousness at least because the Examiner has not shown any suggestion to modify or a reasonable expectation of success. If the '402 reference was modified to add ISO-holes, the method of the '402 patent would not function in its desired capacity. It is highly unlikely that one of ordinary skill in the art would replace the heavy metal discs of '402 with ISO-holes of '361, because the ISO-holes of '361 would be interpreted as a tear the size of the ISO-hole by the method of '402. Therefore, modifying the method of the '402 patent would make it unusable for its intended purpose, and therefore, there is no suggestion to modify '402. Therefore, Applicant respectfully requests that this rejection should be withdrawn.

Claims 2-5 and 7-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over '552 in view of '402 in further view of '361.

Applicant respectfully asserts that '552 does not remedy the shortcomings of the combination of the '402 and '361 patents. Therefore, Applicant respectfully submits that this rejection should also be withdrawn.

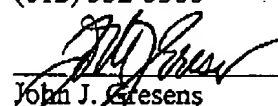
Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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